

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the specification

The specification is amended, as shown above in the amendment to the specification.

A. Amendment

The specification is amended, as shown in the foregoing amendment to the specification, to remove subject matter described as new matter in the rejection. No new matter is added by the removal of this subject matter.

Entry of the amendment to the specification is respectfully requested in the next Office communication.

B. Objection to the specification

Reconsideration of this objection, in light of the amendment to the specification, is respectfully requested.

While the applicant disagrees with the rejection's assertion that the subject matter is new matter, in the interests of furthering prosecution, the applicant has removed the phrase "thereby providing access to the insert plate 13 for removal from the opening" from the specification. This feature is felt to be inherent from the originally filed description, since the decorative main plate and the decorative insert plate can be formed by laser or water jet cutting, and may be mounted on a plurality of backing members, allowing the removal of the decorative insert plate without removing the decorative main plate (specification paragraphs [0013] and [0014]).

Further, because the originally filed drawings clearly show that the decorative insert plate has an outer side that is adjacent to the first surface of the decorative main plate, this feature is not new matter. The decorative insert plate inherently has an outer side adjacent to the first surface of the decorative main plate, which was

originally illustrated in Figures 1 and 3, but was unlabelled. The outer side of the decorative insert plate is clearly shown and defined by the outline of the decorative insert plate in the originally filed drawings in both Figure 1 and 3. The addition of a description and a reference numeral identifying this originally described feature cannot be new matter. Therefore, removal of this objection is respectfully requested.

2. In the claims

As shown in the foregoing amendment to the claims, the claims have been amended to more clearly point out the subject matter for which protection is sought.

A. Claims 1-15

Claim 1 is amended to remove the subject matter indicated as new matter in the rejection. Specifically, the phrase “thereby providing access to the insert for removal from the opening” is deleted, although, as discussed above in section 1, this feature is inherent in the claim. No new matter is added by the removal of this subject matter.

Claims 2-15 are left unchanged.

Entry of the amendment of the claims is respectfully requested in the next Office communication.

B. Rejection of claims 1-15 under 35 U.S.C. § 112, first paragraph

Reconsideration of this rejection, in light of the amendment to claim 1, is respectfully requested.

While the applicant disagrees that the particular subject matter is new matter, in the interests of furthering prosecution, the phrase “thereby providing access to the insert for removal from the opening” in claim 1 has been removed.

As discussed above in section 1, the phrase “wherein the insert plate has an outside adjacent to the first surface of the main plate” is not new matter, since this feature was disclosed, but unlabelled, in the originally filed drawings of Figures 1 and 3. Accordingly, withdrawal of this rejection is respectfully requested.

3. In the drawings

Reconsideration and acceptance of the replacement sheet submitted on August 10, 2005 is respectfully requested.

As discussed above in section 1, the addition of the reference numeral 20 and hashing to better identify the outside of the decorative insert plate that was shown in the originally filed drawings is not new matter. Therefore, acceptance of the replacement sheet submitted on August 10, 2005 is respectfully requested.

4. Rejection of claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 4,830,892 (Nussbaum) in view of U.S. patent 5,604,006 (Ponchaud et al.) and further in view of U.S. patent 4,781,952 (Coscia et al.)

This rejection is respectfully traversed on the basis that the rejection fails to establish a *prima facie* case of obviousness.

A. None of the cited references disclose every limitation of the pending claims

This rejection is respectfully traversed on the basis that the rejection fails to establish a *prima facie* case of obviousness because none of the cited references disclose every limitation of pending claim 1.

To begin with, the Nussbaum patent does not disclose a “decorative main plate” and a distinct “decorative insert plate” having “an outside adjacent to the first surface of the main plate” such that the insert plate is inherently removable in order to be exchanged for another distinct insert plate. The Nussbaum patent discloses a molding strip 10 that is used as a protective body side molding for a vehicle, or can be used as a protective fascia 11 on a bumper (col. 2, lines 36-42). The Nussbaum patent also discloses an insert member 24 that is positioned within an aperture formed in the molding strip (col. 2, line 67 through col. 3, line 2).

The insert member 24 of the Nussbaum patent is designed to be encapsulated integrally within the molding strip 10 (col. 4, lines 24-25). This is accomplished by placing the insert member 24 within the aperture formed in the molding strip, leaving

a space above the insert member 24, and injecting plastic material through conduits 36 to fill the space above the insert member 24, thereby creating the protective overlayer 22 (col. 3, lines 58-62). The surface of the insert member 24 is not adjacent to the outer surface of the molding strip 10, but instead the surface of the insert member 24 is located below the outer surface of the molding strip 10 in order to provide the space for the injected plastic material (Fig. 5).

The conduits used to inject the plastic material provide a strong mechanical bond preventing the overlayer 22, and hence the insert member 24, from removal (col. 4, lines 14-17). The overlayer 22 also bonds to the overlayer 34, further preventing removal of the insert 24 member (col. 4, lines 17-20). This design results in a molding strip that is relatively impervious to attack from the elements and presents no protrusions or crevices that may capture dirt and salt (col. 4, lines 21-23).

Because of the space above the insert member 24 and because the insert member 24 of the Nussbaum patent is not removable from the molding 10, the Nussbaum patent does not disclose all of the limitations required by pending claim 1.

The distinct decorative main plate and decorative insert plate, required by claim 1, inherently allow for the removal of the insert plate in order to provide interchangeability with a different distinct insert plate. Claim 1 requires a decorative main plate having at least one opening therein and at least one distinct decorative insert plate that corresponds to the opening and is snugly disposed within the opening. Because the decorative insert plate is merely snugly disposed with the opening in the decorative main plate, the decorative insert plate must inherently be removable from the decorative main plate.

Further, claim 1 requires a backing, which can include multiple backing members, as described in the specification (paragraph [0013]). Since the insert plate can be on a different backing member than the main plate, the insert plate is inherently removable.

Because the decorative insert plate is inherently removable from the decorative main plate, the decorative insert plate can be replaced with another distinct

decorative insert plate. This is in contrast to the insert 24 of the Nussbaum patent, which is meant to be integrated into the molding in a non-removable manner.

Continuing, the Ponchaud et al. patent, fully discussed in the reply filed on October 4, 2004 in response to the Office action dated June 2, 2004, does not disclose a decorative main plate having an opening to receive the inherently removable decorative insert plate.

Additionally, the Coscia et al. patent, also fully discussed in the reply filed on October 4, 2004 in response to the Office action dated June 2, 2004, does not disclose a “decorative main plate” and a distinct “decorative insert plate” having “an outside adjacent to the first surface of the main plate” such that the insert plate is inherently removable in order to be exchanged for another distinct insert plate.

Because none of the cited references discloses every limitation of claim 1, a *prima facie* case of obviousness cannot stand. Therefore, withdrawal of this rejection is respectfully requested.

B. There is no motivation or suggestion to combine the cited references

This rejection is respectfully traversed on the basis that the rejection fails to establish a *prima facie* case of obviousness because there is no motivation or suggestion to combine the cited references in order to describe every limitation of pending claim 1.

As discussed above in section 4-A, the insert member 24 of the Nussbaum patent is designed to be recessed within the molding strip 10 so that a plastic material can be injected above the insert member in order to form a continuous overlayer that has no protrusions (col. 3, line 57 through col. 4, line 25). The Ponchaud et al. patent discloses a label 16 having an outer surface 17 that is generally planar or close to being generally planar with the outer surface 14 of a decorative insert 12 (col. 4, lines 17-19).

However, one of ordinary skill in the art of molding strips would not be motivated to replace the insert 24 of the Nussbaum patent with the label 16 of the

Ponchaud et al. patent because there would be no room above the label to inject the plastics material that forms the overlayer of the Nussbaum patent that holds that insert member in place and protects the insert member.

Further, since the insert member 24 of the Nussbaum patent has raised indicia 16, if the surface of the insert member was made to be generally planar with the outer surface of the molding strip, the raised indicia would create protrusions above the molding strip. These types of protrusions are exactly what the invention of the Nussbaum patent is trying to avoid (col. 1, lines 43-46; col. 4, lines 21-25). Therefore, the Nussbaum patent teaches away from having the surface of the insert member made to be generally planar with the outer surface of the molding strip.

The Coscia et al. patent simply does not provide any suggestions or motivations to provide for the structure missing from both the Nussbaum and the Ponchaud et al. patents.

Because there is no suggestion or motivation to combine the cited references, a *prima facie* case of obviousness cannot stand. Accordingly, withdrawal of this rejection is respectfully requested.

C. There is no reasonable expectation of success

This rejection is respectfully traversed on the basis that the rejection fails to establish a *prima facie* case of obviousness because there is no reasonable expectation of success for the combination of the cited references.

As discussed above in section 4-B, the combination of the features described in both the Nussbaum patent and the Ponchaud et al. patent would result in two situations that the molding strip in the Nussbaum patent was designed to avoid. First, the insert member 24 of the Nussbaum patent would not be held in place in the molding strip 10 because there would be no overlayer above the insert. Second, the indicia 16 would protrude above the surface of the molding strip 10.

Both of these situations are expressly avoided by the molding strip of the Nussbaum patent, and combining the features of the label in the Ponchaud et al. patent

to the molding strip in the Nussbaum patent would simply destroy the functionality of the molding strip described in the Nussbaum patent.

Further, the Coscia et al. patent does not resolve these issues.

Since there is no reasonable expectation of successfully combining the cited references, a *prima facie* case of obviousness cannot stand. Therefore, withdrawal of this rejection is respectfully requested.

D. Response to Arguments

Although the claims do not preclude a transparent overlay or protective coating, it is clear from the specification that such a coating would be distinct with each of the main plate and the insert plate (paragraph [0013]). Therefore, the insert plate would still be removable from the main plate, even if both the main plate and the insert plate had a protective coating.

Additionally, the insert member 24 of the Nussbaum patent is designed to be integrated into the molding strip 10, as discussed above in section 4-A. While it is true that one could remove the insert member from the molding strip, there is no motivation or suggestion in the prior art to do so. This is especially true since removing the insert member 24 from the molding strip 10 of the Nussbaum patent would destroy the molding strip.

5. Conclusion

As a result of the amendment to the claims and the specification, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. CasSELL", written in a cursive style.

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